

a Group III B element, the composition having a superconductive/resistive transition defining a superconductive/resistive-transition temperature range between an upper limit defined by a transition-onset temperature  $T_c$  and a lower limit defined by an effectively-zero-bulk-resistivity intercept temperature  $T_{p=0}$ , the transition-onset temperature  $T_c$  being greater than 26°K;

(b) maintaining the superconductor element at a temperature below the effectively-zero-bulk-resistivity intercept temperature  $T_{p=0}$  of the superconductive composition; and

(c) causing an electric current to flow in the superconductor element.

### REMARKS

Reconsideration is respectfully requested in view of and changes to the claims and the remarks herein. Please contact the undersigned to conduct a telephone interview in accordance with MPEP 713.01 to resolve any remaining requirements and/or issues prior to sending another Office Action. Relevant portions of MPEP 713.01 are included on the signature page of this amendment. In view of the changes to the claims and the remarks herein, the Examiner is respectfully requested to reconsider the above-identified application. If the

Examiner wishes to discuss the application further, or if additional information would be required, the undersigned will cooperate fully to assist in the prosecution of this application.

In paragraphs 6-7 on pages 12 -16 of the referenced office action Claims 86-87, 96-108, 115, 118, 120, 122, 123, 129-135 and 137-142 have been rejected under 35 USC 112.

The Advisory action dated Feb. 25, 1999 states that applicants response to the final rejection filed 12/14/198 ... will not be entered." In the note the examiner states "[n]ewly added 143 -177 do not simplify or reduce issues for appeal." Claims 143-163 added by this amendment correspond to in claims 86-87, 96-108, 112, 113, 117, 118, 122, and 123. Claims 143-163 added by this amendment have the same wording as claims 86-87, 96-108, 112, 113, 117, 118, 122, and 123 and include all changes suggested by the examiner to overcome the rejections of claims 86-87, 96-108, 112, 113, 117, 118, 122, and 123 claims under 35 USC 112, second paragraph.

Applicants had a telephone discussion with Examiner Kopec prior to submitting applicants' response filed on 12/14/198 in response to the final rejection. Applicants explained to Examiner Kopec that they intended to add claims (claims 143-163 ) that would not add any new issues, would reduce the number of issues under 35-USC 112 in regards to these added claims and would not cause a withdrawal of the final rejection. Examiner Kopec agreed with these comments and preliminarily agreed to enter the amendment filed 12/14/198 containing added claims 143-163. As indicated above that amendment was not entered. The present amendment adds claims 143-163 separately. Applicants request entry of the present amendment for the reasons given above.

In a separate amendment, claims 115-142 have been amended to include all suggestions of the examiner to over come the rejections under 35 USC 112,

second paragraph, except for those directed to the terms "layer-like", "perovskite-like", "rare-earth-like", and "layer-type". These terms occur in claims 86-87, 96-108, 112, 113, 117, 118, 122, and 123. The examiner agreed to enter the amendment to claims 115 - 142 if submitted separately. As stated by applicants in previous responses the terms "layer-like", "perovskite-like", "rare-earth-like", and "layer-type" are terms of art and well understood by persons of skill in the art.

In paragraph 5 of the referenced office action claims 129-131, 134, 135, 139-142 added by applicants in there response dated April 27, 1998 have been rejected under 35 USC 112 as not enabled. Applicants respectfully disagree. The examiner has given no specific reason why these claims are not enabled.

Please charge any fee necessary to enter this paper to deposit account 09-0468.

If the above-identified Examiner's Action is a final Action, and if the above-identified application will be abandoned without further action by applicants, applicants file a Notice of Appeal to the Board of Appeals and Interferences appealing the final rejection of the claims in the above-identified Examiner's Action. Please charge deposit account 09-0468 any fee necessary to enter such Notice of Appeal.

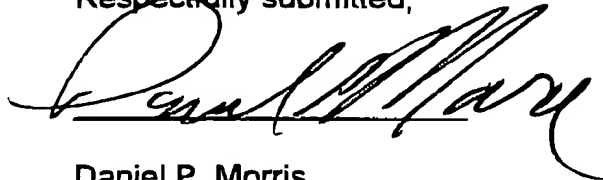
In the event that this amendment does not result in allowance of all such claims, the undersigned attorney respectfully requests a telephone interview at the Examiner's earliest convenience.

MPEP 713.01 states in part as follows:

Where the response to a first complete action includes a request for an interview or a telephone consultation to be initiated by the

examiner, ... the examiner, as soon as he or she has considered the effect of the response, should grant such request if it appears that the interview or consultation would result in expediting the case to a final action.

Respectfully submitted,



Daniel P. Morris  
Reg. No. 32,053  
(914) 945-3217

IBM CORPORATION  
Intellectual Property Law Dept.  
P.O. Box 218  
Yorktown Heights, New York 10598